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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte YASUO IWASAKI

Appeal No. 2001-2119
Application No. 08/826,744

ON BRIEF

MAILED

AUG 28 2003

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, RUGGIERO, and BLANKENSHIP, Administrative
Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-18. An amendment filed January 3, 2000 after final rejection, which was approved for entry by the Examiner, canceled claims 1, 7, 10, 11, 17, and 18. Accordingly, only the Examiner's rejection of claims 2-6, 8, 9, and 12-16 is before us on appeal.

Appeal No. 2001-2119
Application No. 08/826,744

The claimed invention relates to an audio and/or video data recording and reproducing apparatus which receives a multiplexed input data stream having plural channels of at least one of audio and video data, the input data stream being subsequently demultiplexed and recorded. In a reproducing mode, the recorded data is reproduced and multiplexed in a predetermined order to generate an output data stream. In a particular embodiment, the recording structure utilizes a mirror configuration in which plural recording devices record the same audio and/or video data.

Representative claim 2 is reproduced as follows:

2. An audio and/or video data recording and reproducing apparatus comprising:

a receiving means for receiving an input data stream having a plurality of channels of at least one of audio data and video data being multiplexed in a predetermined order;

a demultiplexing means for demultiplexing each one of said plurality of channels from the received input data stream;

a plurality of recording means for recording the demultiplexed each one so that random access is possible, wherein one of said plurality of recording means is configured to record exactly one of said plurality of channels;

Appeal No. 2001-2119
Application No. 08/826,744

a reproducing means for reproducing the recorded
each one from said plurality of recording means; and

a multiplexing means for multiplexing the
reproduced each one in said predetermined order and
generating an output data stream,

wherein each of said plurality of recording means
adopts a mirror configuration having a plurality of
recording apparatuses for recording the same audio
and/or video data.

The Examiner relies on the following prior art:

Nakayama et al. (Nakayama)	4,947,271	Aug. 07, 1990
Windrem et al. (Windrem)	5,754,730	May 19, 1998
	(effectively filed	Sep. 21, 1992)
Kassatly	5,790,177	Aug. 04, 1998
		(filed May 25, 1995)
Morimoto et al. (Morimoto)	5,841,941	Nov. 24, 1998
		(filed Aug. 10, 1995)

Claims 2-6, 8, 9, and 12-16 stand finally rejected
under 35 U.S.C. § 103(a). As evidence of obviousness, the
Examiner offers Kassatly in view of Windrem with respect to
claims 2, 3, 8, 9, 12, and 13, and Kassatly in view of
Nakayama with respect to claims 4 and 14. The combination
of Kassatly in view of Nakayama and Morimoto is offered with
respect to claims 5 and 15, and Windrem is added to this
combination with respect to claims 6 and 16.

Appeal No. 2001-2119
Application No. 08/826,744

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (Paper No. 19) and the Answer (Paper No. 20) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered (see 37 CFR § 1.192(a)).

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of

Appeal No. 2001-2119
Application No. 08/826,744

ordinary skill in the art the obviousness of the invention as set forth in claims 2-6, 8, 9, and 12-16. Accordingly, we affirm.

Appellant's arguments in response to the Examiner's rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 4 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In

Appeal No. 2001-2119
Application No. 08/826,744

re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051-52, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 2, the representative claim for Appellant's first suggested grouping (including claims 2, 8, 9, and 12), Appellant asserts a failure by the Examiner to set forth a prima facie case of obviousness since proper motivation for the proposed combination of Kassatly and Windrem has not been established. In particular, Appellant contends (Brief, pages 9 and 10) that the Examiner has provided no motivation to modify the storage devices of Kassatly to become disk drives. Appellant further asserts (id.) a lack of motivation to then further modify the disk drives to provide a mirrored configuration.

After careful review of the Kassatly and Windrem references in light of the arguments of record, we are in agreement with the Examiner's position as stated in the Answer. In particular, we find Appellant's arguments to be misplaced related to the issue of obviousness of the

Appeal No. 2001-2119
Application No. 08/826,744

modification of the storage devices of Kassatly to be disk drives. Initially, we would point out that, although "disk drive" language appears in independent claim 12, which is part of Appellants' first suggested claim grouping, no such language is recited in representative claim 2, the claim specifically argued by Appellant in the Brief.

Notwithstanding this lack of disk drive recitation in claim 2, we are in agreement with the Examiner (Answer, page 10) that no motivation is needed to modify the storage devices of Kassatly to become disk drives since Kassatly clearly discloses a system which is applicable to and encompasses disk drive storage systems (e.g., Kassatly, column 61, lines 23-50).

We also find, contrary to Appellant's contention, that the Examiner's line of reasoning establishes clear motivation for modifying Kassatly with the mirrored disk array of Windrem. We find no convincing arguments from Appellant that would convince us of any error in the Examiner's assertion of obviousness to the skilled artisan of adding a mirrored storage device configuration providing

Appeal No. 2001-2119
Application No. 08/826,744

redundancy in case of failure of a drive in the array, especially in view of an explicit suggestion to do so at column 2, lines 28-40 in Windrem.

In view of the above discussion, since the Examiner's prima facie case of obviousness has not been rebutted by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of representative claim 2, and claims 8, 9, and 12 which fall with claim 2, is sustained.

We also sustain the Examiner's obviousness rejection of claim 3 as well as claim 13 which falls with claim 13 according to Appellant's claim grouping. We find to be unpersuasive Appellant's assertion that the Examiner's comments (Answer, page 6) concerning the increased bandwidth feature of the disk array of Windrem is merely "a statement of operability" and not a motivation for the combination with Kassatly. In our view, Appellant has mischaracterized the Examiner's comments regarding Windrem's disk array feature as providing the basis for the proposed combination. It is apparent to us, as pointed out by the Examiner (id., at 11), that the Examiner's asserted motivating factor for combining Kassatly with Windrem with regard to claim 3 is

Appeal No. 2001-2119
Application No. 08/826,744

the same as with claim 2 discussed supra, i.e., the mirrored disk drive arrangement provides redundant protection in case of a drive failure.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 4, and claims 5, 14, and 15 which fall with claim 4 according to Appellant's grouping, in which Kassatly is combined with Nakayama, we sustain this rejection as well. Appellant's arguments in response (Brief, pages 15 and 16) focus on the contention that, in contrast to the language of claim 4 which requires the demultiplexing of control data before the recording process, the control data in Nakayama is added during the recording process. In a related argument (id., at 17), Appellant asserts that, as set forth in appealed claim 4, the recording operation is controlled based on the demultiplexed control data while Nakayama does not teach or suggest that demultiplexed control data is used to control recording.

We do not find these arguments from Appellant to be persuasive. Contrary to Appellant's contention, we do not interpret the Examiner's position as suggesting the bodily

Appeal No. 2001-2119
Application No. 08/826,744

incorporation of Nakayama's recording/reproducing system into the system of Kassatly. In our reading of the Examiner's analysis, it is the technique taught by Nakayama of adding ID control data to the input data and multiplexing the data signals with the control data signals to facilitate the recovery of the data signals during reproduction that is being relied upon as a suggestion for the proposed combination. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983), and In re Nievelt, 482 F.2d 965, 968, 179 USPQ 224, 226 (CCPA 1973). In our view, as also pointed out by the Examiner (Answer, page 12), when Kassatly's input data signals are modified with the addition of control data, as taught by Nakayama, these signals would then be demultiplexed and recorded in storage device 230-234 in accordance with the disclosed operation of Kassatly and

Appeal No. 2001-2119
Application No. 08/826,744

in accordance with the requirements of appealed claim 4.

Lastly, we also sustain the Examiner's obviousness rejection of claims 6 and 16 in which the disk array teachings of Windrem are relied upon to address the particular features of these claims. For all of the reasons previously discussed, we remain convinced of the obviousness to the skilled artisan of modifying the applied prior art references with the addition of redundant disk drives as taught by Windrem to protect against disk drive failure. We are further unpersuaded by Appellant's assertion (Brief, page 21) that the Examiner has not shown how Windrem provides for a plurality of recording and reproducing devices, with each device having all of the components such as the receiving means, the demultiplexing means, etc., as set forth in base claims 1 and 14. We agree with the Examiner (Answer, page 14) that, in contrast to Appellant's assertion, the language of Appellant's claims 6 and 16 does not require that the plurality of recording and reproducing devices each have all of the various components recited in

Appeal No. 2001-2119
Application No. 08/826,744

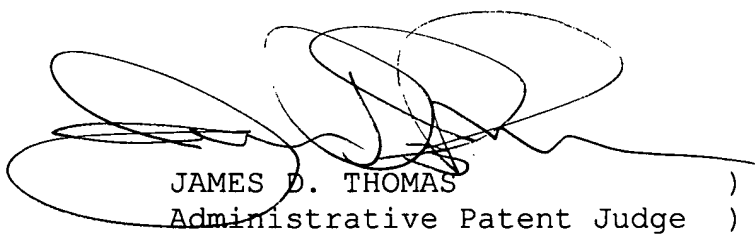
the base claims. In our view, Appellant's arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

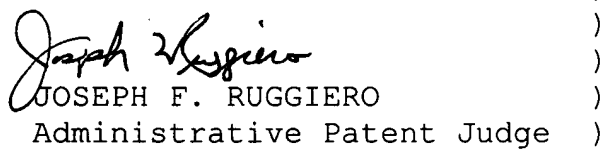
In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 2-6, 8, 9, and 12-16 is affirmed.

Appeal No. 2001-2119
Application No. 08/826,744

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


JAMES D. THOMAS)
Administrative Patent Judge)


JOSEPH F. RUGGIERO)
Administrative Patent Judge)


HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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Appeal No. 2001-2119
Application No. 08/826,744

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